

REMARKS

Introduction

Upon entry of the foregoing amendment, claims 1-22 are pending in the application. No new matter is being presented. In view of the following remarks, reconsideration and allowance of all the pending claims are respectfully requested.

Entry of this Amendment is proper under 37 C.F.R. §1.116 because the claim amendments: (a) place this application in condition for allowance (for the reasons discussed herein), (b) do not raise any new issues requiring further search and/or consideration (since the amendments amplify issues previously discussed throughout prosecution as indicated in the Final Office Action), (c) present the rejected claims in better form for consideration on appeal (should an appeal be necessary), and (d) are necessary and were not earlier presented because they are made in response to arguments raised in the Final Office Action.

Accordingly, for at least the reasons discussed above, entry of this Amendment is respectfully requested.

Rejection under 35 USC §101

Claims 8-13 have been rejected under 35 U.S.C. §101 because the claimed invention is directed to non-statutory subject matter. We respectfully traverse this rejection for at least the following reasons.

Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. (See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Hence, the wording of claims 8 through 13 and the manner in which the claims are construed defines the scope of Applicant's general inventive concept and is the enforceable part of a patent. Therefore, due to at least these reasons, Applicants respectfully request the §101 rejection of claims 8 through 13 be withdrawn and allowance of these claims are earnestly solicited.

Rejection under 35 USC §103

Claims 1-22 have been rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 2005/0278741 to Robarts et al. (hereinafter "Robarts") in view of U.S. Patent No. 5,583,560 to Florin et al. (hereinafter "Florin"). We respectfully traverse this rejection for at least the following reasons.

Independent claims 1, 5, 8, 14, 18, and 22

Regarding independent claims 1, 5, 8, 14, 18, and 22, Applicants respectfully submit that Robarts in view of Florin fail to teach or suggest each limitation as recited in the claims. More specifically, the Examiner alleges that the Florin picture-in-picture window 380 could be interpreted to read on Applicants' "sub PIG screens." However, Applicants respectfully submit that Robarts in view of Florin fail to teach or suggest, among other things, "detecting the EPG information on the current channel to display in texts on the EPG background screen, displaying turned moving pictures of the current channel on the main PIG screen while sequentially detecting the EPG information for other channels, capturing pictures from the other channels, and displaying the detected EPG information in texts on the EPG background screen and displaying the captured pictures as still pictures on the sub PIG screens," as recited in independent claim 1 and similarly recited in independent claims 5, 8, 14, 18, and 22.

Robarts in view of Florin, alone or in combination, do not teach or suggest Applicants' claim limitation that when each channel is tuned, the EPG information and the image are detected and displayed on an EPG screen. As admitted by the Examiner on page 3 of the Office Action mailed September 26, 2008, "Robarts does not disclose having a plurality of PIG screen displayed in the EPG" while displaying detected EPG information for each PIG screen on the EPG background screen. Florin, on the other hand, displays a central picture-in-picture window 375 along with smaller picture-in-picture windows 380 on the Florin screen 180, but fails to simultaneously detect and display any EPG information regarding the picture-in-picture windows, as recited in claims 1, 5, 8, 14, 18, and 22. (Florin, FIGS. 33-35). Therefore, neither Robarts or Florin teach or suggest simultaneous detecting and displaying of a plurality of

images within PIGs and EPG information for each tuned channel within an EPG background screen. Hence, Applicants respectfully submit that Robarts in view of Florin fail to teach or suggest, among other things, "detecting the EPG information on the current channel to display in texts on the EPG background screen, displaying turned moving pictures of the current channel on the main PIG screen while sequentially detecting the EPG information for other channels, capturing pictures from the other channels, and displaying the detected EPG information in texts on the EPG background screen and displaying the captured pictures as still pictures on the sub PIG screens," as recited in independent claim 1 and similarly recited in independent claims 5, 8, 14, 18, and 22.

Additionally, Applicants respectfully submit that Florin cannot modify Robarts without rendering Robarts unsatisfactory for its intended purpose.

If proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. (See *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984) – See MPEP 2143.01(V))

Florin teaches that when the user of Florin's device desires to see electronic program guide (EPG) information for the current channel or other channels while in Florin's picture-in-picture function (pix function), as demonstrated in Florin's FIGS. 33-35, the Florin user is required to depress the Florin information button 136 on Florin's remote control. (See Florin, col. 20, lines 50-67 and page 3 of the Office Action mailed September 26, 2008). This extra step of depressing the Florin information button 136 destroys the intended function of the Robarts EPG screen which specifically teaches that program information on numerous channels will be available on one EPG screen *without* the need to depress any button on a remote control. "Program grid 178 consists of multiple program tiles 184 Each program tile 184 has the program title and any secondary program description information, such as closed caption, stereo, etc." (Robarts, paragraph [0069]). Therefore, the teaching of pressing the Florin information button 136 destroys the intended function of Robarts; hence Applicants' respectfully submit that Robarts in view of Florin fail to teach or suggest, among other things, "detecting the EPG information for other channels, capturing pictures from the other channels, and displaying the detected EPG information in texts on the EPG background screen and displaying the

captured pictures as still pictures on the sub PIG screens," as recited in independent claim 1 and similarly recited in independent claims 5, 8, 14, 18, and 22.

Moreover, Applicants respectfully submit that claims 1, 5, 8, 14, 18, and 22 are allowable over Robarts in view of Florin for at least the following additional reasons. Applicants further submit that not only does modifying Robarts with Florin render Robarts unsatisfactory for its intended purpose, but the Examiner's combination of Robarts in view of Florin is also improper, since it relies on impermissible hindsight gleaned from Applicant's disclosure. In contrast to the Examiner's statement of broader use, Robarts in view of Florin teaches away from Applicant's invention.

"Any judgment on obviousness is in a sense necessarily a reconstruction based on hindsight reasoning, but so long as it takes into account only knowledge which was within the level of ordinary skill in the art at the time the claimed invention was made and does not include knowledge gleaned only from the applicant's disclosure..." *In re McLaughlin* 443 F.2d 1392, 1396 (CCPA 1971).

More specifically, Florin teaches of the extra step of depressing the information button 136 on the Florin remote control in order to specifically limit the picture-in-picture display with pictures and video from the channels. (Florin, FIGS. 33-35). In other words, "a user may watch a motion picture or television program, including the audio track, in window 375, while viewing multiple other programs simultaneously." (*Id.*, col. 20, lines 37-40). Only after depressing the Florin information button 136 does information appear on a channel in the Florin picture-in-picture display. Therefore, any text on Florin's picture-in-picture display would minimize the Florin viewer experience and therefore teach away from "displaying the detected EPG information in texts on the EPG background screen and displaying the captured pictures as still pictures on the sub PIG screens," as recited in independent claim 1 and similarly recited in independent claims 5, 8, 14, 18, and 22.

The Examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. If the Examiner does not produce a *prima facie* case, the Applicants are under no obligation to submit evidence of nonobviousness. The initial evaluation of *prima facie* obviousness thus relieves both the Examiner and Applicant from evaluating evidence beyond the prior art and the evidence in the specification as filed until the art has been shown to suggest the claimed invention. (See MPEP 2142) To establish a *prima facie* case of

obviousness, three basic criteria must be met. First, the intended function of reference(s) must not be destroyed upon combining or modifying the reference(s). Second, there must be reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim elements. Since for at least the reason that the Examiner has not shown that Robarts in view of Florin teach or suggest all the features of independent claims 1, 5, 8, 14, 18, and 22, the Examiner therefore has not provided a sufficient factual basis to support a *prima facie* case of obviousness with respect to claims 1, 5, 8, 14, 18, and 22. Accordingly, Applicants respectfully submit that independent claims 1, 5, 8, 14, 18, and 22 are allowable over Robarts in view of Florin, and withdrawal of this rejection and allowance of these claims are earnestly solicited.

For at least the reason that claims 2-4, 6, 7, 9-13, 15-17, and 19-21 depend from independent claims 1, 5, 8, 14, and 18, and therefore contain all of the features recited therein, dependent claims 2-4, 6, 7, 9-13, 15-17, and 19-21 are also allowable over Robarts in view of Florin, for at least the reasons in which independent claims 1, 5, 8, 14, and 18 are allowable, as pointed out above. Accordingly, withdrawal of the rejection and allowance of dependent claims 2-4, 6, 7, 9-13, 15-17, and 19-21 are respectfully requested.

Conclusion

It is respectfully submitted that a full and complete response has been made to the outstanding Office Action and, as such, there being no other objections or rejections, this application is in condition for allowance, and a notice to this effect is earnestly solicited.

If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at the number provided below.

If any further fees are required in connection with the filing of this amendment, please charge the same to our Deposit Account No. 502827.

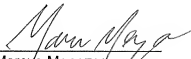
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Respectfully submitted,

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